

EXHIBIT E

122203

To: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

A METHOD FOR ORGANIZING DIGITAL
IMAGES

Express Mail Label No.

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Date: 12-22-03

19270 US PTO
10/744537

122203

First Named Inventor (or Application Identifier):

Carl A. Testa, et al

Enclosed are:

1. Specification 6. Assignment of the invention to
2. 29 Sheet(s) of drawing(s) 7. Certified copy of a priority
3. Information Disclosure Statement Under 37 CFR 8. Associate Power of Attorney
1.97.

4. Combined Declaration for Patent Application and Power of Attorney:
4a. New
4b. Copy from a prior application (37 CFR 1.63(d) (for continuation/divisional with Box 11 completed)

5. Incorporation by Reference (useable if Box 4b is checked) The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

9. Deletion of Inventor(s).
Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).

10. If a 111A application prior to examination of the above-identified application, amend the specification at Page 1, after the title, by inserting the following:

-CROSS REFERENCE TO RELATED APPLICATION

Reference is made to and priority claimed from U.S. Provisional Application Serial No. , filed , entitled .

If a **CONTINUING APPLICATION**, check appropriate box and supply the requisite information:

11. Continuation Divisional Continuation-in-part (CIP) of prior application No: 09/640,642,
12. Please address all written communications to Pamela R. Crocker, Patent Legal Staff,
Eastman Kodak Company, 343 State Street, Rochester, NY 14650-2201.
Please Direct all telephone calls to Frank Pincelli at 585-588-2728.

The filing fee has been calculated as shown below:

| FOR: | NO. FILED | NO. EXTRA | RATE | FEE |
|---|-----------|-----------|--------------|---------------|
| BASIC FEE | | | | \$ 770 |
| TOTAL CLAIMS | 16 - 20 = | -4 | x 18 = | \$ 0 |
| INDEPENDENT CLAIMS | 2 - 3 = | -1 | x 86 = | \$ 0 |
| MULTIPLE DEPENDENT CLAIM PRESENTED | | | + 290 | \$ 0 |
| | | | TOTAL | \$ 770 |

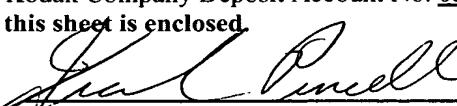
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The Commissioner is hereby authorized to charge any additional filing fees required under
37 CFR 1.16 or credit any overpayment to Eastman Kodak Company Deposit Account No. 05-0225.

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Frank Pincelli/phw
Telephone: 585-588-2728
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Attorney for Applicants
Registration No. 27,370

JUN 08 2006

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Customer No. 01333

Response under 37 C.F.R. 1.116
- Expedited Examining Procedure -
Examining Group 2167

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Carl A. Testa, et al

A METHOD FOR ORGANIZING
DIGITAL IMAGES

Serial No. 10/744,537

Filed 22 December 2003

Group Art Unit: 2167
Confirmation No. 1635
Examiner: Jack M. Choules

I hereby certify that this correspondence was sent
by facsimile transmission to the United States
Patent and Trademark Office on the date set forth
below.

Carl J. Testa
Thomas F. Strome
June 8, 2006
Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

Response Under 37 CFR 1.116

In response to the Office Action dated February 8, 2006, Applicant
respectfully requests reconsideration in view of the following amendments and
remarks.

Amendments to the Claims are reflected in the listing of claims which begins on
page 2 of this paper.

Remarks/Arguments begin on page 5 of this paper.

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application. Please amend claims 1, 6 and 9 and newly add claims 17-18 so that the current status of all claims is as follows:

Listing of Claims:

1. (currently amended) A method of organizing a plurality of hard copy prints, each of said hard copy prints having an image thereon, comprising the steps of:

obtaining hard copy prints from a plurality of different sources;
~~grouping the obtained hard copy prints into one or more categories, each category separated by an associated machine readable instruction form;~~
~~placing said hard copy prints into a desired order;~~
~~digitally scanning said one or more categories and said associated machine readable instruction form to create one or more digitized image categories and associated digitized category data, respectively;~~
~~combining each image of said one or more digitized image categories with said associated digitized category data said hard copy prints in said desired order to produce a plurality of modified digital image files digitized images; and~~
~~storing the modified digital image files.~~

~~grouping said plurality of digital digitized images in an order in which they have been scanned and providing a product or service with respect to said grouping of the plurality of digitized images.~~

2. (original) A method according to claim 1 wherein said product comprises an album page.

3. (original) A method according to claim 1 wherein said product comprises a computer storage media having said images.

4. (original) A method according to claim 3 wherein said storage media comprises a CD.

5. (original) A method according to claim 1 wherein said product comprises a digital image file containing said image.

6. (currently amended) A method according to claim 1 further comprising ~~the step of scanning an providing instructions on said instruction form which provides an instruction with respect relating to said images.~~

7. (original) A method according to claim 6 wherein said instruction provides information as to grouping of said images.

8. (original) A method according to claim 6 wherein said instruction provides information about at least one of said images.

9. (currently amended) A method of organizing a plurality of images provided on a plurality of separate hard copy prints, comprising the steps of:

placing said hard copy prints into a desired order;
placing in front of at least one of said hard copy prints an instruction form capable of being scanned;
scanning said hard copy prints so as to obtain a digital record of said images on said hard copy prints;
scanning said instruction form so as to obtain information provided on said instruction form; and
combining said digital record of said images with said information provided on said instruction form said hard copy prints in said desired order to produce a plurality of modified digital image files.

10. (original) A method according to claim 9 wherein said instructions are followed with respect to said images.

11. (original) A method according to claim 9 further comprising the step of:

providing at least one good and/or service in accordance with said instructions.

12. (original) A method according to claim 9 wherein said instruction is provided in the form of an icon.

13. (original) A method according to claim 12 wherein said icon is provided on a sticker.

14. (original) A method according to claim 12 wherein said icon is automatically associated by said scanner with respect to a particular instruction and/or information.

15. (original) A method according to claim 9 wherein said instruction form includes at least one machine readable instruction.

16. (original) A method according to claim 9 further comprising the step of searching said images using said information provided on said instruction form.

17. (new) A method according to claim 1 further comprising providing a product or service created from said at least one of the plurality of modified digital image files.

18. (new) A method of organizing a plurality of hard copy prints, each of said hard copy prints having an image thereon, comprising the steps of:

obtaining hard copy prints from a plurality of different sources;
grouping the obtained hard copy prints into one or more categories, each category separated by an associated machine readable instruction form;
digitally scanning the obtained hard copy prints and associated machine readable instruction form to create digitized images and digitized category data, respectively;

storing the digitized images with the digitized category data.

REMARKS

Favorable reconsideration of this application is requested in view of the above amendments and the following remarks. Claim 1, 6 and 9 are amended and claims 17 and 18 are newly added. Support for the amendments can be found on at least page 11, lines 8-23 of Applicants' Specification. No new matter has been added. Claims 1-18 remain actively pending in the case. Reconsideration of the claims is respectfully requested.

In paragraph 9 on page 4 of the Office Action, claims 1-8 are rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse the rejections. Applicants submit that on page 7, lines 24-27, Applicants' Specification discloses that "for the sake of simplicity in describing the present invention, the following discussion will be directed [to] a system wherein the images [are] provided in the form of hard copy prints that are capable of being digitally scanned." Subsequently, Applicants' Specification discloses "the images to be grouped may be obtained from a variety of different sources." See page 14, lines 18-20. Therefore, Applicants' invention provides for obtaining hard copy prints from a plurality of different sources. Accordingly, Applicants respectfully submit that Examiner withdraw the rejection.

On page 5 of the Office Action, claims 1-16 were rejected under 35 USC §103(a) as being unpatentable over Hiroshima et al. (4,771,551) in further view of Squilla et al. (6,123,362). On page 7 of the Office Action, claims 1-16 were rejected under 35 USC §103(a) as being unpatentable over Hiroshima (4,771,551) in further view of Kato (6,141,111). Applicants respectfully traverse the rejections.

As admitted by the Office Action, Hiroshima does not provide digital scanning. Further, Hiroshima fails to teach or disclose at least combining each image of said one or more digitized image categories with said associated digitized category data to produce a plurality of modified digital image files as recited in Applicants' independent claims. Rather, Hiroshima merely discloses a device to applying angle data marks to original photographs adhered to a cylinder of an image data input scanner. Col. 2, lines 48-53; Col. 4, lines 34-36.

Sequilla fails to remedy the deficiencies of Hiroshima as Sequilla fails to teach or disclose at least combining each image of said one or more digitized image categories with said associated digitized category data to produce a plurality of modified digital image files. Sequilla peels sticker images from a sticker sheet 18 to be placed on a collage. Col. 5, lines 58-60.

Kato fails to remedy the deficiencies of Hiroshima and Sequilla as Kato fails to teach or disclose at least combining each image of said one or more digitized image categories with said associated digitized category data to produce a plurality of modified digital image files. Rather, Kato discloses extra-copy printing wherein images are provided by a digital still camera. Col. 7, lines 37-39.

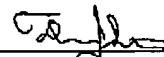
Furthermore, the cited references disclose obtaining images from a single source rather from a plurality of different sources (i.e., film, CD, uploads etc.) and grouping said plurality of digital images in an order in which they have been scanned.

Therefore, in view of the above remarks, Applicants' claims 2-6, 17 and 10-15 depend from claims 1 and 9, respectively, and include the features recited in the independent claims. Applicants respectfully submit that claims 2-6, 10-15 and 17 are also patentably distinct over the cited references. Nevertheless, Applicants are not conceding the correctness of the Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Deposit Account No. 05-0225.

Respectfully submitted,



Attorney for Applicant(s)
Registration No. 53,950

Thomas J. Strouse/phw

Rochester, NY 14650

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

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PATENT LEGAL STAFF
343 STATE STREET
ROCHESTER, NEW YORK 14650-2201**

DATE: 8 June 2006

TO: EXAMINER: Jack Choules FAX NO. 571-273-8300
GROUP 2167
U.S. PATENT OFFICE

FROM: Thomas J. Strouse FAX NO. (585) 477-4646
PHONE NO. 585-588-2728

RE: U.S. Serial No. 10/744,537
Filed 12/22/03
Docket No.: 80967A

Attached is Applicant's response to the office action of February 8, 2006.

Total Pages Including Cover Sheet 10

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Docket 80967ATJS
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Carl A. Testa, et al

A METHOD FOR ORGANIZING
DIGITAL IMAGES

Serial No. 10/744,537

Filed December 22, 2003

Group Art Unit: 2167
Confirmation No. 1635
Examiner: Jack M. Choules

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THOMAS J. STROUSE, Reg. No. 53,950

June 8, 2006

Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.17 AND 1.136

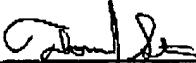
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Applicants petition for a further extension of month from
the expiration date of the extension requested by Applicants
in the Request dated .

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05-0225. A duplicate copy of this request is enclosed.

Respectfully submitted,



Thomas J. Strouse /phw
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Thomas J. Strouse, Reg. No. 53,950

June 3, 2006

Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.17 AND 1.136

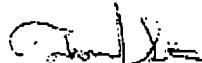
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Respectfully submitted,



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